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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,646	02/10/2006	Alan David Borthwick	PG5041USW	5114

23347 7590 09/06/2007
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EXAMINER

BARKER, MICHAEL P

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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09/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,646	Applicant(s) BORTHWICK ET AL.	
	Examiner Michael P. Barker	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3 July 2007, Amendment After NonFin. Rej.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant canceled **Claims 7 and 9** and amended **Claims 5, 10, and 11**. **Claims 1-6, 8, 10, and 11** are pending in this Application. *Note*: This case has been transferred from Examiner Nyeemah Grazier to Examiner Michael Barker.

Response to Remarks

Rejections Withdrawn/Overcome:

- Applicant's arguments regarding the rejection put forth under 35 U.S.C. 103(a) are persuasive. The rejection over **Claims 1-6, 8, 10, and 11** is withdrawn, as the reference relied upon to make the rejection is owned by Applicant, negating it as a 102(e) reference.
- Applicant's amendment to **Claim 10** overcomes the rejection put forth under 35 U.S.C. 112, ¶1. Accordingly, the rejection over **Claim 10** is withdrawn.
- Applicant's amendment to **Claim 11** overcomes the rejection put forth under 35 U.S.C. 112, ¶2. Accordingly, the rejection over **Claim 11** is withdrawn.
- The obviousness-type double patenting (ODP) rejection of **Claim 11** over Claim 3 of copending Application No. 11/548,404 is withdrawn. There is an overlap in scope between the process disclosed in the '404 Application and the instant Application. However, unlike the maintained/FINAL rejections which follow, the '404 Application does not recite a species with which the Examiner can proffer the obviousness rationale associated with H for CH₃ substitutions. Instead, such a rejection would require picking and choosing from amongst the listed substituents in each case to come up with the species needed to ground an obviousness-type rejection.
- The ODP rejection of **Claims 1-6, 8, 10, and 11** over Claims 1-9, 12, 14, and 15 of copending Application No. 11/378,947 (US Patent No. 7,226,929) is withdrawn. No grounds for an obviousness-type rationale associated with species exists in the '929 Patent.
- The ODP rejection of **Claims 1-6, 8, 10, and 11** over Claims 1-9, 12, 14, and 15 of copending Application No. 11/384,094 (US Patent No. 7,226,929) is withdrawn. No grounds for an obviousness-type rationale associated with species exists in the '929 Patent.

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Rejections Maintained/Made FINAL:

- **Claims 1-6 and 8** were rejected over Claims 1-9 of U.S. Patent No. 7,186,717 (ODP). The thrust of the rejection was overlap in scope and H for CH₃ substitution. This rejection is maintained and made FINAL. Applicant has not shown evidence of unexpected results nor amended the claims to overcome this rejection. Applicant is invited to submit evidence of unexpected results associated with the instantly claimed compounds versus, for instance, those disclosed in Claim 8 of the '717 Patent.
- **Claims 1-6 and 8** were provisionally rejected over Claim 1 of copending Application No. 10/537,645 (ODP). The thrust of the rejection was overlap in scope and H for CH₃ substitution. This rejection is maintained and made FINAL. Applicant has not shown evidence of unexpected results nor amended the claims to overcome this rejection. Applicant is invited to submit evidence of unexpected results associated with the instantly claimed compounds versus the compound disclosed in Claim 1 of the '645 Application.
- **Claim 10** was provisionally rejected over Claim 1 of copending Application No. 11/548,402 (ODP). The thrust of the rejection was overlap in scope and H for CH₃ substitution. Claim 10 has since been amended to narrow the scope of conditions susceptible to amelioration by a thrombin inhibitor. **Claim 10** should have originally been rejected over Claim 1, as well as Claims 9-11, of the '402 Application. Claim 10 of the instant Application now recites species of conditions susceptible to amelioration by a thrombin inhibitor. Also, Claims 9-11 of the '402 Application recite species differing from the instantly claimed genus by the substitution of H for CH₃, which is not a patentable distinction without a showing of unexpected results. This rejection is maintained and made FINAL.
- **Claims 1-6 and 8** were provisionally rejected over Claims 1-7 and 9 of copending Application No. 11/548,395 (ODP). The thrust of the rejection was overlap in scope and H for CH₃ substitution. This rejection is maintained and made FINAL. Applicant has not shown evidence of unexpected results nor amended the claims to overcome this rejection. Applicant is invited to submit evidence of unexpected results. See: (E)-2-(4-chlorophenyl)-N-[(3S)-1-[(1S)-1-methyl-2-morpholin-4-yl-2-oxoethyl]-2-oxopyrrolidin-3-yl]-ethanesulfonamide, Claim 8 of '395 Application.

Conclusion

Claims 1-6, 8, and 10 remain rejected. **Claim 11** is drawn to allowable subject matter.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to

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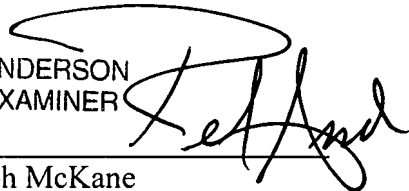
expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699. The unofficial fax phone for this group are (571) 273-8300.

Michael P. Barker
Patent Examiner, AU 1626
Technology Center 1600

REBECCA ANDERSON
PRIMARY EXAMINER



(for) Joseph McKane
Supervisory Patent Examiner, AU 1626
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